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APR 14 2004

OFFICE OF PETITIONS

In re Application of	:	
Janet L. Pan	:	
Application No. 10/654,790	:	DECISION ON PETITION
Filed: September 4, 2003	:	UNDER 37 C.F.R. §1.53(e)
Attorney Docket No. Y0165-002	:	
Title: USE OF DEEP-LEVEL	:	
TRANSITIONS IN SEMICONDUCTOR	:	
DEVICES	:	

BACKGROUND

This is a decision on the "petition to correct filing date," which is properly treated as a petition pursuant to 37 C.F.R. §1.53(e), filed January 26, 2004, requesting the application be accorded a filing date of September 4, 2003 with Figure 16 considered part of the original disclosure.

The application was deposited on September 4, 2003. However, on November 25, 2003, the Office of Initial Patent Examination (OIPE) mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), stating that the application appeared to have been deposited without Figure 16. The notice further indicated that an executed oath or declaration and the surcharge associated with the late filing of an oath or declaration were required.

In response, on January 26, 2004, applicants filed the present petition. Applicants request that the application, including Figure 16, be accorded a filing date of September 4, 2003. Petitioner has included the following four submissions in an attempt to have this figure accepted as present on filing:

- A statement that Applicant's copy of the "9/4/03 filing papers¹" contains the missing figure
- A statement that Applicant's copy of the "9/4/03 filing papers²" contains both an Express Mail certificate and a return postcard, both of which make reference to the missing figure
- A copy of the Express Mail label
- A copy of applicants' postcard receipt which properly itemizes "Drawings - 16 sheet(s)/Figs. 1 to 16."

Receipt of the declaration and the surcharge associated with the late filing of the same is acknowledged.

THE RELEVANT PORTIONS OF THE CODE OF FEDERAL REGULATIONS AND MPEP

37 C.F.R. § 1.8 sets forth, in part:

§ 1.8 Certificate of mailing or transmission.

- (a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
 - (1) Correspondence will be considered as being timely filed if:
 - (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
 - (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and
 - (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.
 - (2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:
 - (i) Relative to Patents and Patent Applications –
 - (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an

¹ Petition, page 1.

² Id.

application filing date, including a request for a continued prosecution application under §1.53(d);

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, in part:

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

(emphasis added)

ANALYSIS

The argument and evidence submitted is not persuasive.

With regards to the first submission, the Patent Office file is the official record of the papers originally filed in this application. A review of the official file reveals that Figure 16 was not included on filing. The PTO file is the official record of the papers originally filed in this application. Unfortunately, the papers which Petitioner has in his personal file are not relevant.

Regarding the first portion of the second submission, the Express Mail certificate cannot be used to establish that a drawing was received in the Office, pursuant to 37 C.F.R. §1.8(a)(2)(i)(A), reproduced above.

Regarding the third submission, an Express Mail label can be used to establish that an application was deposited with the United States Postal Service on a particular date for the purposes of establishing the date of deposit as the filing date, pursuant to 37 C.F.R. §1.10. However, 37 C.F.R. §1.10 cannot be used to establish that a particular item was included on filing.

Regarding both the second portion of the second submission and the fourth submission, it is noted that the postcard does not contain a date stamp³. As such, it cannot serve as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped on the postcard. Therefore, Petitioner's postcard receipt cannot constitute persuasive evidence.

³ Perhaps the date stamp was placed on the reverse side of the postcard? All that was provided was a copy of the front of the postcard.

CONCLUSION

For these reasons, the petition must be DISMISSED.

Any response must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The response should include a cover letter entitled "Renewed Petition under 37 CFR 1.53(e)."

The reply to this letter may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁵ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁶ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.